

REMARKS

Claims 1-4 are pending. Reconsideration and allowance based on the following remarks are respectfully requested.

Claims 1-4 were rejected under 35 U.S.C. § 103(a) over Tabata et al. (U.S. Patent 6,317,665). The rejection is respectfully traversed.

The Examiner acknowledges on page 3, lines 6-10, that Tabata et al. do not disclose or suggest a motor-generator having a rotary shaft connected to an output shaft side of a torque converter, as recited in claim 1, but concludes that it would have been obvious to include a motor-generator having a rotary shaft connected to an output shaft side of the torque converter, "since it has been held that rearranging parts of an invention involves only routine skill in the art."

Although unstated in the Office Action, it appears that the Examiner is relying on the rationale used by the court in In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1970), as discussed in MPEP § 2144.04VI.C. As discussed in that MPEP section, the court concluded that claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.

MPEP § 2144.04 states: "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." MPEP § 2144.04 further states: "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection."

It is respectfully submitted that the facts of In re Japikse are not sufficiently similar to the instant application for the Examiner to use the rationale used by the court. In particular, it is respectfully submitted that "to include a motor-generator having a rotary shaft connected to an output shaft side of the torque converter" of Tabata et al., as proposed by the Examiner, would modify the operation of the device.

Moreover, the instant application clearly explains how the provision of a motor-generator having a rotary shaft connected to an output shaft side of the torque converter clearly provides benefits not recognized or achieved by the prior art. Accordingly, it is inappropriate for the Examiner to rely solely on case law as the rationale to support the obviousness determination.

Furthermore, as recited in claim 1, the input shaft of the internal combustion engine is an input shaft of the torque converter, the rotary shaft of the motor-generator is connected to an output shaft side of the torque converter, and the multistage transmission is connected to the output shaft side of the torque converter. The control means is for saddling the motor-generator with torque for an axle of the vehicle during the time period when slip occurs in the torque converter in a shifting process of the multistage transmission. Therefore, the invention of claim 1 presupposes that a slip occurs between the input shaft and the output shaft of the torque converter when a speed change operation is performed. There is no disclosure or suggestion of such a slip in the torque converter 2 of Tabata et al. during the speed change operation discussed in column 8, lines 5-22 of Tabata et al.

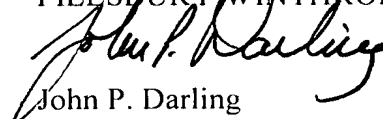
During the slip, the motor-generator is operated, as either a motor or a generator, to reduce the slip in the torque converter. However, in the system of Tabata et al. the slip occurs when both the engine 1 and the motor-generator 3 are operating, and in order to achieve Tabata et al.'s objective of preventing transmission of the shock of switching drive sources (column 1, lines 61-64), the motor-generator 3 must be connected to the input side of the torque converter 2, not the output side of the torque converter. Accordingly, it would not have been obvious to rearrange the parts of the system of Tabata et al.

Reconsideration and withdrawal of the rejection of claims 1-4 over Tabata et al. are respectfully requested.

In view of the above remarks, Applicant respectfully submits that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
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